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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,065	12/01/1999	STEFAN BODENSCHATZ	BEIERSDORF-5	9425

7590

09/26/2003

Norris McLaughlin and Marcus, P.A.

220 East 42nd Street  
30th Floor  
New York, NY 10017

EXAMINER

MATHEW, FENN C

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 09/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/445,065

Applicant(s)

BODENSCHATZ ET AL.

Examiner

Fenn C Mathew

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Drawings***

1. The proposed drawing correction with regards to figure 5 have been disapproved because they introduce new matter. Please see paragraph 2 of the office action dated September 25, 2002. The explanatory text provided in the amendment did not provide evidence to overcome prior contentions by the examiner including showing the support strap splitting then reconnecting to the support strap at the location show in fig. 5. Additionally, the proposed fig. 5 does not show the support strap dorsally on the thorax, but rather on the neck or cervical vertebrae.

### ***Specification***

2. The amendment filed May 19, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The recitation "the second of said two parts being adapted to run from said point ventrally over the thorax of said patient to intersect and rejoin said first part" has not been supported by the originally filed disclosure, which would raise new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See discussion above.

***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 3-6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Abolina (SU 321252). See paragraph 16 of the office action dated November 28, 2001.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abolina in view of Lindenmeyer (5,599,283). Abolina discloses the claimed invention except for the shells being encapsulated. Lindenmeyer discloses in col. 4, lines 1-20, that it is advantageous to provide a silicone coating to the shells of an orthopedic appliance in

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order to maintain friction between the device and a user's arm. Therefore, one having ordinary skill in the art would have been inclined to encapsulate the forearm and upper arm portions of Abolina.

9. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abolin in view of Munoz. Referring to claim 7, Abolin discloses the claimed invention including a strap (3) that runs from the wrist area to a shoulder area. It is unclear as to whether the strap approaches the neck area. Munoz discloses that it is advantageous to have the strap run from the shoulder area to the neck area in order to provide additional support. Therefore, one skilled in the art would be inclined to have the strap of Abolin support the neck and shoulder areas.

10. Referring to claim 8, Abolin discloses the claimed invention except for a partial pad. Munoz discloses in column 3, lines 47-49 that it is desirable to have a pad on the shoulder strap in order to provide extra comfort to a user, thus the skilled artisan would be inclined to provide a pad as taught by Munoz in order to provide additional comfort.

11. Claims 11-12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abolina in view of Johnson (U.S. 4,550,869). Referring to claim 11, Abolina does not disclose that the straps are made from laminated foam or laminated nonwoven fabric. Johnson teaches in figures 1-4, in col. 2, lines 64-68, column 3, lines 1-32, and 51-57 and column 4, lines 8-20 that it is known in the sling art to make straps from laminated foam in order to provide comfort and a load-bearing structure to the user. Thus one having ordinary skill in the art would have known to make the straps of laminated foam in order to provide comfort and a load-bearing structure to the user.

12. Referring to claim 12 and 20, see the above discussion. Johnson discusses longitudinal expansion. However, Johnson also teaches and suggests in column 3, lines 4-11 the straps are made from relatively non-elastic material in order to carry tensile loads. As such, one having ordinary skill in the art would have known to limit the longitudinal expansion to <35% and <10% under a load of about 50 N in order to carry tensile loads.

13. Claims 13-15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abolina in view of Ford. See paragraph 20 of the above cited office action.

14. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abolina in view of Ford as applied to claim 13 above and further in view of Cherubini. See paragraph 21 of the above cited office action.

### ***Response to Arguments***

15. Applicant's arguments filed 5/19/2003 with respect to claims 1, 3-6, 10, 13-15, and 19 have been fully considered but they are not persuasive. Please see paragraph 16 of the above cited office action. In addition, applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

16. Applicant's arguments, see paper no. 16, filed 05/19/2003, with respect to the rejection(s) of claim(s) 1-2, 7-8, 11-12, and 20 under Munoz have been fully considered

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and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Abolina.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fenn C Mathew whose telephone number is (703) 305-2846. The examiner can normally be reached on Monday - Friday 9:00am - 5:30pm.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
NICHOLAS D. LUCHINI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

September 17, 2003

fcm

